

REMARKS

Reconsideration of the present application is respectfully requested. Claims 1-28 were originally presented. Claim 19 has been amended and claim 24 has been canceled, so that claims 1-23 and 25-28 are currently pending. Claims 1, 13, and 19 are in independent form.

In the Office Action mailed December 9, 2004, the Examiner rejected claims 1-28 under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. Nos. 76,272 (Tayntor); 3,704,204 (Heck); and 2,182,171 (Coyner). For the reasons given below, Applicant submits that independent claims 1, 13, and 19 are patentable over Tayntor, Heck, and Coyner.

In order to establish a *prima facie* case of obviousness (1) the references must teach or suggest all the claim limitations, (2) there must be some suggestion or motivation to modify or combine the reference teachings, and (3) there must be a reasonable expectation of success. (MPEP §2143)

Applicant submits that Tayntor, Heck, and Coyner do not teach or suggest all the claim limitations of independent claims 1, 13, and 19. For example, independent claims 1 and 19 each recite a bone meal-to-palatability enhancer weight ratio in the range of from about 1:10 to about 1:1, while independent claim 13 recites a bone meal-to-palatability enhancer weight ratio in the range of from about 1:5 to about 1:2. Neither Tayntor, Heck, nor Coyner discloses the bone meal-to-palatability enhancer weight ratios recited in independent claims 1, 13, and 19.

Heck does not disclose any particular values for the amounts or ratios of bone meal and palatability enhancer. Heck simply discloses a medium, comprising meat and bone meal, that is use to test a composition for detecting salmonellae. Heck does not provide any values for the amounts or ratios of the ingredients of the test medium.

Tayntor discloses a compound comprising 20 pounds of bone-dust, one pound of sulphate of iron and, optionally, one ounce of caraway. Coyner discloses a compound comprising 50 percent bone meal and 50 percent calcium sources (i.e., calcium lactate, calcium gluconate, and precipitated calcium carbonate). Claims 1, 13, and 19 of the present application recite a palatability

enhancer that is "highly palatable to carnivorous animals." One skilled in the art would clearly recognize that the iron sulphate and/or carroway disclosed in Tayntor and the calcium sources disclosed in Coyner are not "highly palatable to carnivorous animals," as required by claims 1, 13, and 19. Therefore, Tayntor and Coyner do not disclose any ingredient that falls within the meaning of Applicant's claimed palatability enhancer. Because Tayntor and Coyner do not disclose Applicant's claimed palatability enhancer, Tayntor and Coyner cannot possibly disclose any amount of palatability enhancer or any ratio of bone meal-to-palatability enhancer.

Therefore, because Tayntor, Heck, and Coyner do not teach or suggest all the limitations of Applicant's independent claims, Applicant submits that the Examiner has failed to establish a *prima facie* case of obviousness.

Further, the Examiner states in the Office Action that "[c]laims 1 - 3 differ from the reference in the particular amounts of ingredients. However, it is seen that it would have been within the skill of the ordinary worker to use particular amounts of ingredients in the composition. Therefore, it would have been obvious to use known ingredients as shown by the above ingredients to make the claimed compound." (Office Action, page 2, lines 16-20) Applicant submits that the Examiner's rationale quoted above is simply a conclusory statement that does not provide proper rationale for supporting the obviousness rejection.

In order to establish a *prima facie* case of obviousness, the Examiner must point to some suggestion or motivation to modify or combine the teachings of the references. The suggestion or motivation to modify/combine the reference must be found either in the references themselves or in the knowledge generally available to one skilled in the art. The Examiner has not pointed to any suggestion or motivation in Tayntor, Heck, and Coyner to modify or combine the disclosures therein to arrive at Applicant's claimed invention. Thus, the Examiner is apparently relying on the knowledge generally available to one skilled in the art as support for modifying/combining the teachings of Tayntor, Heck, and Coyner. However, Applicant reminds the Examiner that "[i]t is never appropriate to rely solely on 'common knowledge' in the art without evidentiary support in

the record, as the principle evidence upon which the rejection was based.” (MPEP §2144.03 A.)

As discussed above, Heck is the only one of the Tayntor, Heck, and Coyner references that discloses a composition comprising both bone meal and a palatability enhancer. However, Heck does not disclose any values for the amounts or ratios of the bone meal and palatability enhancer. Therefore, the Examiner is apparently taking the position that, based on the disclosure of Heck, Tayntor, and Coyner, employing Applicant’s claimed amounts and ratios of bone meal and palatability enhancer in the composition of Heck would have been common knowledge in the art. If the Examiner is indeed taking official notice that the claim amounts and ratios of bone meal and palatability enhancer are common knowledge in the art, Applicant requests that the Examiner do so explicitly. However, Applicant reminds the Examiner that, “[o]fficial notice unsupported by documentary evidence should only be taken by the Examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known.” (MPEP §2144.03 A.) Further, applicant reminds the Examiner that if such official notice is taken, the Examiner “must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge.” (MPEP §2144.03 B.)

Therefore, because the Examiner has fail to provide proper suggestion or motivation to modify or combine the teachings of Tayntor, Heck, and Coyner in a manner that would arrive at Applicant’s invention of independent claims 1, 13, and 19, Applicant submits that the Examiner has failed to establish a *prima facie* case of obviousness.

In the Office Action, the Examiner also rejected independent claims 13 and 19 as being unpatentable over Tayntor, Heck, and Coyner, in further view of U.S. Pat. Nos. 3,908,025 (Miller); 5,200,218 (Lasater); and 6,280,779 (Nadeau). Applicant submits that Miller, Lasater, and Nadeau do not cure the deficiencies of Tayntor, Heck, and Coyner discussed above. For example, Miller, Lasater, and Nadeau do not disclose Applicant’s bone meal-to-palatability enhancer weight ratios recited in claims 13 and 19.

In the Office Action, the Examiner states that Miller discloses a composition containing bone meal and meat meal, where “meat (palatability enhancer) is used in amounts of 10-25T (sic) and meat by-products are used in amounts of 0-15%.” (Office Action, page 3, lines 13-16) Although Applicant admits that the table in column 3 of Miller discloses a composition that contains bone meal and various palatability enhancers (e.g., liver, chicken, meat, and fish), nowhere in Miller is it taught or suggested that the bone meal-to-palatability enhancer weight ratio should be in the ranges recited in claims 13 and 19. In fact, the actual amount of bone meal employed in the Miller composition is wholly speculative because the table in column 3 does not give a specific value or range for the amount of bone meal. Rather, the table in column 3 of Miller simply states that “meat and bone meal” should be present in the amount of 10 to 25 percent, and since no ratio of meat meal to bone meal is provided in Miller, no specific amount of bone meal can be implied from Miller. Therefore, Miller could not possibly disclose Applicant’s claimed bone meal-to-palatability enhancer weight ratios recited in claims 13 and 19.

In the Office Action, the Examiner states that “Lasater et. al. disclose bone meal used in various amounts.” (Office Action, page 3, lines 16 and 17) While this is true, Lasater fails to disclose any amount of a palatability enhancer that is highly palatable to carnivorous animals. Therefore, Lasater could not possibly disclose Applicant’s claimed bone meal-to-palatability enhancer weight ratios recited in claims 13 and 19.

In the Office Action, the Examiner states that “Nadeau et al. disclose protein (meat) in amounts of 42% and ash (bone meal) in amounts of 7.82.” (Office Action, page 3, lines 17 and 18) Applicant submits that Nadeau does not disclose any particular amount of bone meal. Although the Examiner apparently asserts that “ash” is the same as “bone meal,” Applicant submits that this assertion is in error. Tables IV-VIII of Nadeau disclose the ingredients and nutrient content of six different conventional pet foods. Only Tables VI and VII list “steamed bone meal” as an ingredient; however, all the Tables list “ash” as a significant percentage of the nutrients contained therein. In view of the above, it is not proper for the Examiner to assume that ash content values listed in the

Tables of Nadeau inherently disclose bone meal content because the pet foods of Tables IV, V, and VIII that contain no bone meal have just as much or more ash content as the pet foods of Tables VI and VII that contain bone meal. Therefore, it can not be assumed that ash content is the same as bone meal content. Thus, the Examiners statement that “the use of steamed bone meal ... is assumed to give the ash content” is submitted to be in error.

As further evidence that ash content is not the same as bone meal content, Applicant has provided Exhibit A, which was printed from the Purina One website. Exhibit A discusses the meaning of the term “ash” as it relates to pet food. Exhibit A states, “Ash is a general term that refers to the non-combustible residue that is left after burning a sample of the food for at least two hours at 600 degrees C (1112 F). This ash contains calcium, phosphorous, magnesium and other minerals ...” Thus, ash content is not directly related to bone meal content and, as evidenced by the Tables of Nadeau, pet food can have significant ash content without having any bone meal content. In view of the foregoing, Applicant submits that Nadeau does not disclose any particular amount of bone meal. Therefore, Nadeau could not possibly disclose Applicant’s claimed bone meal-to-palatability enhancer weight ratios recited in claims 13 and 19.

Therefore, because Tayntor, Heck, Coyner, Miller, Lasater, and Nadeau do not teach or suggest all the limitations of independent claims 13 and 19, Applicant submits that the Examiner has failed to establish a proper *prima facie* case of obviousness. Further, the Examiner has fail to point to a proper source of a suggestion or motivation to modify or combine the teachings of Tayntor, Heck, Coyner, Miller, Lasater, and Nadeau in a manner that would arrive at Applicant’s invention of independent claims 13, and 19.

Applicant submits that claim 13 is also patentable over the prior art references of record because, for example, claim 13 recites a composition “consisting essential of” a palatability enhancer and bone meal. As stated in MPEP §2111.03, “The transitional phrase ‘consisting essentially of’ limits the scope of the claim to the specified materials or steps ‘and those that do not materially affect the basic and novel characteristic(s)’ of the claimed invention. (Quoting *In re Herz*,

Application No. 10/600,321
Amendment dated March 8, 2005
Reply to Office Action of December 9, 2004

537 F.2d 549, 551-52 (CCPA 1976)(emphasis in original)) Applicant submits that all the cited references disclose additional materials (i.e., materials in addition to bone meal and the palatability enhancer) that would materially affect the basic and novel characteristics of the present invention. Therefore, claim 13 is submitted to be patentable of the prior art references of record.

In view of the above, Applicant submits that independent claims 1, 13, and 19 are patentable of the prior art reference of record. Dependent claims 2-12 depend from independent claim 1; dependent claims 14-18 depend from independent claim 13; and dependent claims 20-23 and 25-28 depend from independent claim 19. These dependent claims recite additional patentable features, but should also be allowable based on their dependence on allowable independent claims 1, 13, and 19.

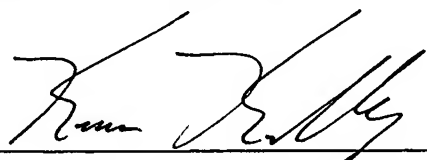
Applicant respectfully requests that a timely Notice of Allowance be issued in this case. Should the Examiner have any questions, please contact the undersigned at (800) 445-3460.

The Commissioner is hereby authorized to charge any additional fees associated with this communication or credit any overpayment to Deposit Account No. 19-0522.

Respectfully submitted,

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